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IN THE

Supreme Court of the United States

October Term, 1925

No. 87

INDEPENDENT WIRELESS TELEGRAPH
COMPANY,

Petitioner,

v.

RADIO CORPORATION OF AMERICA,
Respondent.

On Writ of Certiorari
to the United States
Circuit Court of Ap-
peals for the Second
Circuit.

BRIEF OF AMICUS CURIAE, AND APPLICATION TO FILE A BRIEF AND BE HEARD AS SUCH.

APPLICATION FOR PERMISSION TO FILE BRIEF AND TO BE HEARD AMICUS CURIAE.

I respectfully ask for permission to file a brief and to be heard *amicus curiae*.

I represent the DeForest Radio Telephone & Telegraph Company, an *involuntary* party plaintiff to the bill of complaint.

The respondent filed its bill against the petitioner and the American Telephone & Telegraph Company. It joined the DeForest Company as a party plaintiff without its consent.

In paragraph 8 of the bill (R., p. 2) it is alleged that the DeForest Company, by an agreement dated March

16th, 1917, transferred "*a license*" under the patents in suit to the Western Electric Company, which in turn assigned all of the rights acquired by it under the agreement to the Telephone Company, and that the respondent acquired a "*license*" through the latter under a series of agreements detailed in paragraph 9 of the bill.

The first point of the brief of counsel for the respondent is that the *title* to these patents is in the Telephone Company and that the DeForest Company is but a non-exclusive licensee. An extensive argument to establish this proposition is advanced.

The question of the title to these patents is of very great importance to the respondent and the DeForest Company, because there is pending in the United States District Court for the District of Delaware a suit brought by the DeForest Company against the respondent, in which the question of title to these patents is directly in issue and, as to one of the parties, is in all probability decisive of the suit. On an application for preliminary injunction in that suit, Judge Morris held the title to be in the DeForest Company (*DeForest v. Radio Corporation*, 3 Fed. [2nd], 847). The final hearing in the case has been had and it is now awaiting decision.

Two similar suits, instituted by the DeForest Company against other concerns, are pending in the United States District Court for the Eastern District of Pennsylvania. The question of title to the patents in suit is of exactly the same importance in those cases as it is in the Delaware suit. Outside of the case at bar and the cases instituted by the DeForest Company just mentioned, the question of the title to these patents is of no importance because the patents have expired.

If it becomes necessary for this court, in the case at bar, to pass upon the question of title, the DeForest Company desires to have its position regarding the title placed be-

fore this court, to the end that its interests may be protected in this litigation as fully as is possible.

Consequently, I respectfully ask, as counsel for the DeForest Company, for permission to file a brief and be heard *amicus curiae*.

I have been informed by counsel for the petitioner and respondent that they will not object.

B R I E F .

The *question of title*, although made the leading point in the brief of the respondent, *does not* arise in this case if it should be held that the respondent was justified in joining the DeForest Company as a plaintiff without its consent. That it had a right to do so is argued under Points II to VIII, inclusive, of respondent's brief, and the petitioner's brief is devoted exclusively to demonstrating that it had no such right. As the question of title is of very great importance to the DeForest Company and the respondent in other pending litigations, referred to above, it is thought that this court will not care to go into that question in this suit unless it finds it necessary and proper to do so in order to properly dispose of this suit.

The grounds upon which the application for the certiorari was based did not involve the question of title to the patents, and we cannot conceive that if that had been the ground of the application, this court would have allowed the writ. The application, on the other hand, to quote from the petition (p. 2), was based on the following grounds:

1. That the decision of the Court of Appeals proposes vitally to restrict the effect of the decision of this Court in *Crown, etc., Co. v. Nye, etc., Works*, 261 U. S., 24, 43 Sup. Ct., 254, by establishing the proposition that the essential party, the owner of the patent, may be brought into the case as a party

plaintiff against its will merely by adding to the caption of the bill of complaint the name of the owner of the patent and reciting in the bill of complaint that the owner of the patent was asked to join and refused and is outside of the jurisdiction of the Court; thereby introducing great unsettlement and chaos in the field of patent litigation wherever infringement injurious to the rights of a licensee is alleged.

2. That the series of agreements by which the respondent Radio Corporation of America in the instant case acquired its license rights under the two patents here in suit conveys to the Radio Corporation similar rights in literally hundreds of important patents in the new radio industry. The litigation on those patents is already very large and promises to be larger. For that reason immediate final determination of the right of the Radio Corporation to sue *without joining the legal owner* of the patents is of vital importance to this young industry.

That the question of title would arise in this case was not foreshadowed in the bill of complaint because in paragraph 8 it is alleged that the DeForest Company transferred a "*license*" under the patents. The brief of the petitioner in this court states that "the bill of complaint alleges the title to the patents in suit is in the DeForest Radio Telephone & Telegraph Company." The important questions which the petition for the writ of certiorari stated that it was desired this court should settle, are reiterated on page 2 of the petitioner's brief.

Consequently this court may not feel bound to consider the question of title, even though it holds with the petitioner on the other questions. (See *Great Northern R. R. Co. v. U. S.*, 208 U. S., 452.)

ARGUMENT.

THE TITLE TO THE PATENTS IN SUIT IS IN THE DE FOREST RADIO TELEPHONE & TELEGRAPH COMPANY.

The question of title depends entirely upon the agreement entered into between the DeForest Company and the Western Electric Company under date of March 16th, 1917 (R., pp. 17-21, fols. 35-44). Prior to that agreement, the entire right, title and interest in the patents was vested in the DeForest Company subject only to an outstanding license to Sidney S. Myers. It becomes essential, therefore, to see exactly what was transferred to the Western Electric Company (the Telephone Company) and what was *reserved* to the DeForest Company by the agreement.

Agreement of March 16, 1917.

1. The granting clause states:

"The said DeForest Company hereby * * * grants * * * a *license* * * *"

"The said *license* is granted * * * for all transferable rights of said DeForest Company of any kind or nature whatsoever in said inventions, patents and applications, *except the rights herein-after expressly reserved to itself by the DeForest Company*. The said license granted is exclusive * * * *except for the rights expressly reserved herein by the DeForest Company.*"

It will be noted that the parties called the instrument a *license* rather than an assignment, and that it purported to grant merely a *license*

"to make, use, install, operate and lease, and to sell or otherwise dispose of to others for sale, installation and operation, apparatus and systems embodying or made or operating in accordance with"

the inventions mentioned in the agreement. The subsequent provision that the license was granted "for all transferable rights of said DeForest Company" was manifestly inserted because the DeForest Company had previously parted with certain rights in many of the inventions to Sidney S. Myers.

Moreover, the parties purported to grant only such rights *as were not reserved in the instrument to the DeForest Company*.

In *Littlefield v. Perry*, 88 U. S., 205, and *Waterman v. McKenzie*, 138 U. S., 252, it was held that an instrument in order to be construed as an assignment of a patent grant must convey (1) the *entire* right, title and interest of the patent; or, (2) an undivided portion of the entire right, title and interest (such as a one-half interest, a quarter interest, etc.); or, (3) the entire right, title and interest of the patent or an undivided portion thereof within and throughout a certain specified portion of the United States.

Consequently, the only way the agreement in question can be found to be an *assignment* is that it transferred the *entire* right, title and interest of the patent. A transfer of anything short of the entire right, title and interest would constitute only a license.

It is apparent that by the granting clause of the agreement the DeForest Company did not grant the *entire* right, title and interest because it granted "all transferable rights * * * *except* the rights * * * *expressly reserved to itself*." Therefore, the rights which the DeForest Company reserved to itself, it never parted with. The respondent attempts to confine the granting clause to the first portion thereof and would ignore the remainder. In other words, it says the grant was of "all transferable rights of the said DeForest Company of every kind and nature whatsoever." *That was not the granting*

clause. The grant, on the contrary, consists of the quoted portion plus the continuing portion "*except the rights hereinafter expressly reserved to itself by the DeForest Company.*"

It is not proper, of course, to break the granting clause in half and construe the same without reference to the remainder thereof.

In the usual retained license class of grant, the *entire* right, title and interest of the patent passes from the patentee to the grantee, and thereafter, i. e., after the grantee has acquired the entire monopoly, the grantor takes back a license, i. e., a flow of privilege from the grantee back to the grantor, which the grantee acquired and had the right to give back to the grantor. In the instant case, however, the Telephone Company at no time ever acquired by the *granting clause*, or otherwise, the rights which the DeForest Company reserved to itself. The Telephone Company was never in a position to *license* the DeForest Company because the rights retained by the DeForest Company *never passed from the DeForest Company to the Telephone Company.* Therefore, the Telephone Company, never having owned the privilege itself, could certainly not pass the privilege to the DeForest Company.

In *Gayler v. Wilder*, 10 How., 477, Wilder, the assignee of a patent for safes, sued in his own name. He had given Herring an *exclusive* right to make and sell the safes in the State of New York, where the infringement occurred. Wilder, however, *reserved* to himself the right to make safes in New York not within fifty miles of New York City, and to sell them in the State of New York on payment of the same royalty that Herring was to pay. This court held, as stated by Judge Hand in the case at bar,

"that in order to be an assignment authorizing the

licensee to sue in his own name, *the license must exclude the licensor*, and that, as Wilder had reserved the right to make and sell safes within New York he remained the owner and he alone could sue" (R., p. 52).

Judge Hand also said in this case:

"The authority of that case (*Gaylor v. Wilder*) has remained unshaken to the present time" (R., p. 52).

It is impossible to reconcile this "unshaken authority" of the Supreme Court with respondent's contention. This Court stated that to be an assignment the grantor must exclude everyone, *including himself*. In the instant case the grantor, DeForest Company, did not exclude itself, but did expressly refuse to transfer to the Telephone Company the rights it enumerated as reservations in the agreement.

Rights Never Parted with by the DeForest Company.

The rights which the DeForest Company acquired under the patent, and which it never parted with, are:

- (1) Non-exclusive, assignable rights to make, use and sell for one purpose (paragraph 1 of March, 1917, agreement).
- (2) *Exclusive*, assignable rights to make, use and sell for another purpose (paragraph 2).
- (3) *Exclusive*, non-transferable, personal rights to grant a *non-exclusive license* to a particular concern (paragraph 3 of the agreement).
- (4) Non - exclusive, non - transferable, personal rights
 - (a) To make and sell to the United States.
 - (b) To make and sell to amateurs.
 - (c) To make and sell to private users.

- (d) To make and sell for use on ships.
 - (e) To make and use for radio distribution of news and music.
 - (f) To make and sell for use receiving apparatus for the reception of such news and music.
 - (g) To make, use and sell apparatus in reproduction of words and music from telephone and graphophone records (paragraph 4 of the agreement).
- (5) The right to sue infringers in fields in which it retained rights.

It thus appears that the DeForest Company reserved *exclusive* rights to make, use and sell, in certain fields, *exclusive* rights to grant certain licenses; and non-exclusive rights to make, use and sell in other fields.

As will also be presently shown, the DeForest Company reserved the right to institute suits for infringement in any of the fields in which it "possesses rights," and thus reserved *the right of exclusion* (subject to be terminated by the Telephone Company in certain instances) *in any field in which it could make, use and sell*. But this is all that constitutes a patent monopoly,—the right of exclusion. This is all the DeForest Company acquired with the grant of the Letters Patent, and this is what it did not part with (*Crown Co. v. Nye Tool Works*, 261 U. S., 24).

The retention by the DeForest Company of the right of exclusion alone would defeat an interpretation of the document as an assignment.

In the respondent's brief the statement is made that the DeForest Company "transferred to the Western Electric Company all transferable rights." As before stated, what was actually transferred to the Western Electric Company was a *license* for all transferable rights, *except such as were expressly reserved to itself by the DeForest Company*. Manifestly, there is a vast difference between the two.

2. In the agreement of March 16th, 1917, it was specifically provided that either party thereto might

"institute and conduct suits against others for infringement of any of said patents within the fields in which it possesses rights, but all such suits shall be conducted at the expense of the party bringing them, which party shall be entitled to retain any judgment recovered in any such suits" (R., p. 19, fol. 40).

An instrument is always construed according to the intention of the parties. Certainly, when the parties agreed that the DeForest Company might maintain suits for infringement in the fields in which it possessed rights, it is impossible to attribute to them an intention to *assign* the patents to the Western Electric Company or its assignee, the Telephone Company.

When the DeForest Company retained the right to sue in certain instances, it necessarily did not part with the whole of such right of exclusion.

Moreover, if the parties had intended the instrument to be an assignment, they would not have reserved a right in the DeForest Company to sue, because that company could not have brought suit unless it was the holder of the legal title. The provision for the retention of any damages recovered by the DeForest Company was undoubtedly inserted because of the nature of the license given to the Telephone Company. If it had not been for that clause, probably the Telephone Company could have claimed any moneys that might be recovered.

The reservation of a right to sue in the Telephone Company was entirely consistent with the existence of title in the DeForest Company, because the former, as an exclusive licensee, under the decisions existing at the time the agreement was made, could bring suit in its own name and that of the patent owner without the latter's consent.

(See cases cited in *Radio Corporation v. Independent Wireless Telephone Company*, 297 Fed., 520, 523.)

Judge Hand held that that was "settled law" until the decision in *Crown Company v. Nye Tool Works, supra*, which he felt had changed it. The Circuit Court of Appeals disagreed with him on this latter point.

That being the law at the time this agreement was drawn, it was entirely consistent with the title remaining in the DeForest Company for the parties to provide that the Telephone Company might bring suits. On the other hand, if the title was not in the DeForest Company and the latter was a mere licensee, the provision regarding the bringing of suits was ineffective for any purpose because DeForest Company could not bring a suit.

In construing the instrument, the Court, of course, will not attribute to the parties an intention to confer *upon the DeForest Company a right (to sue) which they could not confer and which, under the law, the DeForest Company could not exercise.*

3. Some of the rights retained by the DeForest Company were *exclusive*. This fact alone, we submit, demonstrates that the parties never intended the instrument in question to be an assignment. It is impossible, we think, to construe an instrument which *purports to be a license*, and which reserves *exclusive* rights in the licensor, to be an assignment. Such an agreement would not come within any of the above stated requirements that this court has held (*Littlefield v. Perry, supra*, and *Waterman v. McKenzie, supra*) essential to constitute an assignment. It is said in the brief of respondent that no exclusive rights were reserved by the DeForest Company *in the patents in suit*. That is true, but to be able to accept the thought on which this attempted segregation of the plaintiff's reservations is based, would necessitate considering the agreement of

March, 1917, in cut-up portions, not as a whole, i. e., *that it is a license as to some patents and an assignment as to others*. This, we submit, cannot be done. The agreement must be taken as a *whole* and construed as a *whole*, either to be a *license or an assignment*. Having in mind that while there are a great number of patents (rights under which were conveyed to the Telephone Company by the document), *only one granting clause was employed*, and that the terms of the granting clause limit the *quantum* of the grant of ALL of the patents, it must follow that the document is either an assignment as to *all* of the patents or a mere license as to *all*. An intention cannot be attributed to the parties to have the instrument operate as an assignment as to some patents and a license as to others when there is no attempt in the agreement to make any such differentiation, especially where they have denominated the instrument a *license* as to all patents and purported to merely grant a license.

4. If by the March, 1917, agreement it was intended that the title to the patent should pass to the Western Electric Company, then the provision that the latter might

“transfer to others, in whole or in part, the rights granted by this instrument, and may assign rights hereunder, or grant licenses to various persons, firms or corporations for the several uses to which the inventions are applicable” (R., p. 21),

was mere surplusage. If the title passed to the Western Electric Company, it immediately, by virtue of its ownership alone, acquired all of those rights and it would not have been necessary to *expressly grant them*.

Litigation in Which the Question of Title to the Patents in Suit Has Been Passed Upon Directly or Indirectly.

Judge A. N. Hand, in a suit in the Southern District of New York brought by the Radio Corporation against one

Emerson, a surreptitious infringer of the patent, to which suit the DeForest Company was not a party, held that the Telephone Company, by the agreement of March 16th, 1917, had acquired title to the patent in suit. His opinion is not reported. It will be noted that if he had held differently, a flagrant infringer would have been able to escape the consequences of his wrongdoing.

Subsequently, however, the Radio Corporation brought the present suit.

The DeForest Company was joined as a party plaintiff *without its consent*, it being alleged that it was not within the jurisdiction and could not be made a party defendant. A motion was made to dismiss the bill on the ground

"that the DeForest Radio Telephone & Telegraph Company, the *owner* of the patents in suit, has not joined in this litigation as a party plaintiff by duly signing and verifying the bill of complaint herein, and the plaintiff Radio Corporation of America is not such a licensee under the patents as to permit it to sue in its own name, in the name of the owner of the patents in suit, or to sue in the name of the owner of the patents joining itself as licensee under the patents" (R., p. 50).

Judge Learned Hand, after reviewing the March, 1917, agreement and the other agreements above set forth by which the Radio Corporation claims to have acquired its rights under the patent in suit, dismissed *the bill for lack of parties*. He squarely held that the DeForest Company was the owner of the patent and that "the actual presence of the owner" before the court was necessary.

Judge Manton, who wrote the opinion of the Circuit Court of Appeals, said that the Radio Corporation was an *exclusive licensee* in a certain field, and that being an exclusive licensee, it could maintain the suit in the name of the DeForest Company, the owner of the patent, with-

out the latter's consent, and ended the opinion with the statement (R., p. 61, fol. 138) :

"We have heretofore held that appellant's (Radio Corporation) license entitles it to sue *in the name of the patent owner*, and this disposes of the last argument on the appeal. Decree Reversed."

It will therefore be seen that while the Court of Appeals differed with Judge Hand as to the right of an exclusive licensee (assuming that the Radio Corporation was such) to make the owner of a patent a party plaintiff without his consent, it apparently concurred with his holding that the DeForest Company was the owner of the patent, because otherwise the decision could have been rested upon the mere fact that the DeForest Company was not the owner of the patent and hence not a necessary party. No attempt was made to rest the decision on any such ground.

As stated in the brief of counsel for the respondent, Judge Morris has held the title to be in the DeForest Company (*DeForest Radio Tel. & Tel. Co. v. Radio Corp.*, 3 Fed. [2nd], 847).

The Authorities Cited by Respondent.

We have already discussed *Gayler v. Wilder*. That decision was in no way shaken by *Littlefield v. Perry*, 21 Wall., 205, for in that case there was, in the first instance, "in most unmistakable language, an *absolute* conveyance by the patentee of his patent and inventions described" (21 Wall., 210). Thus, the instrument by which the assignee acquired his rights complied with the requirement set forth in the opinion of the Chief Justice in *Gayler v. Wilder*, that

"the assignment must undoubtedly convey to him (the assignee) the *entire* and unqualified monopoly which the patentee held * * * *excluding the patentee himself, as well as others.*"

The patentee retained nothing. The rights which he acquired in the patent, he acquired by an *independent supplemental* agreement. The Court held that the two instruments, when construed together, conveyed to the assignee the title to the patent and granted a license back from the assignee to the patentee of the right to use the patent in certain furnaces (p. 220).

This was the construction given to that case by Judge Wallace in *Gamewell Fire-Alarm Telegraph Co. v. Brooklyn*, 14 Fed., 255, where he said (p. 256) :

"From the reasoning of the opinion it is evident, if there had never been a transfer of the patentee's right to the limited use of the invention, the interest transferred would not have been considered as vesting the statutory title in the assignees."

Waterman v. Mackenzie (138 U. S., 252) not only did not in any way depart from *Gayler v. Wilder*, but reiterated the principles upon which the latter rested.

In the recent decision of *Crown Die & Tool Co. v. Nye Tool & Machine Works*, 261 U. S., 24, the decision in *Gayler v. Wilder* is treated as expressing the existing law. For instance, in that case Chief Justice Taft said:

"In *Gayler v. Wilder*, 10 How., 477, it was held that the grant of an exclusive right to make and vend an article within a certain territory upon paying to the assignor a cent per pound, reserving to the assignor the right to use and manufacture the article by paying the assignee a cent per pound, was only a license, * * *. The effect of the opinion in that case is that the monopoly granted the patentee is for one entire thing; and, in order to enable an assignee to sue, he must have received *the entire and unqualified monopoly* in the territory specified."

On the strength of that opinion, as thus construed, the Court in part based its ultimate conclusion.

Judge Davis speaking for the Circuit Court of Appeals of the Third Circuit in *Russell v. Boston Card Index Co.*, 276 Fed., 4, 7, said:

"The grant of anything short of an *entire, unqualified* monopoly in the territory specified is a mere license. *Gayler & Brown v. Wilder* (10 How.), 51 U. S., 477, 494; *Waterman v. Mackenzie*, 138 U. S., 252; *Pope Manufacturing Co. v. Gormully, &c., Co.*, 144 U. S., 248, 250."

It therefore seems undoubtedly true, as Judge Learned Hand in the case before cited said, that *Gayler v. Wilder* remains unshaken to the present day by any decisions of the Supreme Court.

If the decision of Judge Holt in *Sirocco Engineering Co. et al. v. Monarch Ventilator Co.*, 184 Fed., 84 (cited by respondent), is not in harmony with *Gayler v. Wilder*, it can, of course, be given no weight. It is clear, however, that Judge Holt considered the case within *Littlefield v. Perry*, where, as before pointed out, there was, in the first instance, a complete and unqualified assignment and then the giving back of a license from the assignee to the patentee. That is what Judge Holt therefore considered to be the legal effect of the instrument which he was construing. This is borne out by an examination of the granting clause in that instrument. This, taken from the demurrer book in the files of the court, reads as follows:

"Now, Therefore, in consideration of One Dollar, and other good and valuable considerations, duly paid and rendered unto the Patentee by the Company, the receipt whereof is hereby acknowledged, the Patentee does hereby grant unto the Company the sole and exclusive license to manufacture, sell and use, and to sub-license others to manufacture, sell and use, within and throughout the United States of America and the territories and dependencies thereof (including Porto Rico, Hawaii and the

Philippines), each and all of the inventions covered by the patents recited in the annexed schedule, and by the patents to be granted upon each and all of the applications recited in said schedule, the same to continue to the full ends of the terms of said Letters Patent granted and to be granted respectively."

It will be noted that a *period* terminates the granting clause. Thereafter, in the instrument, is contained the provision quoted in 184 Fed., 84. Thus it appears that by the *granting clause*, the *entire* right, title and interest passed from the grantor, so that the grantee thereafter legally could return to the grantor a license under the monopoly that it acquired. Judge Holt also cites, as do counsel for the respondent in this case, *Pope Manufacturing Co. v. Clark*, 46 Fed., 789, 792. It was stated in that case that the complainant acquired

"the title to this Overman patent * * * *by assignment* from Albert H. Overman and the Overman Wheel Company; and *by agreement of that date* it was stipulated between the same parties that the Overman Wheel Company should have the right * * * to make, use, and sell the inventions described in that patent."

The Court then said:

"It is clear that the legal title of the Overman patent is in the complainant, and that the Overman Wheel Company is only a licensee."

The transfer and the license were thus affected by *two instruments* as in *Littlefield v. Perry*. This further demonstrates that Judge Holt considered that the instrument before him was of exactly the same nature as the combined instruments in *Littlefield v. Perry*.

In *Frankfort & Co. v. Pepper*, 26 Fed., 336 (the opinion is very brief), Judge Wallace said:

"The conveyance was a *grant* of the patent, with a reservation of a license to the grantor; and is in legal effect as though the grantor had made an *unqualified transfer* of the patent to the complainant, and had *at the same time received* from the complainant a license back."

Manifestly, the instrument before the Court in that case contained, in the first instance, a *complete grant* to the assignee. In that aspect, the case is no different from *Littlefield v. Perry*.

The grant to the assignee and the giving back of a license to the assignor can, of course, be accomplished in one instrument as well as two. The distinctive characteristic is whether the owner of the patent has, in the first instance, *parted with all that he had*. If he has, the assignee is in a position to give back to the assignor, either in a separate or in the same instrument, a license. If, on the other hand, he did not part with all that he had, as in the case at bar where the grant was of a license "for all transferable rights * * * *except the rights hereinafter expressly reserved to itself by the DeForest Company*," then under *Gayler v. Wilder* the instrument is merely a license.

In *Griggs, Cooper & Co. v. Erie Preserving Co.*, 131 Fed., 359, not only was the court dealing with a trade-mark (which, so far as we are able to gather, is not necessarily controlled by the rules relating to the transfer of patents) but the instrument was clearly an assignment of the character of that which was before the court in *Littlefield v. Perry*. The granting clause was

"does hereby *grant, license, assign and set over* unto the said parties of the second part, and their successors in business the *absolute and exclusive use* * * * *as fully and entirely as the same would have been held by the said party of the first part had this agreement not been made.*"

Later in the instrument there is a proviso, which, in its legal effect, was clearly a license from the assignee to the assignor. It provides that nothing therein contained should prevent the assignor "from using and enjoying the said trade-marks hereby assigned as aforesaid" on certain goods. Thus there was, in the first instance, a complete transfer of the assignor's rights in the trade-mark. The parties treated it as an assignment because in the proviso, wherein the assignor's future rights were prescribed, they used the expression "*hereby assigned.*" The legal effect of the *proviso* was exactly the same as the second agreement in *Littlefield v. Perry*.

In *Andrew Jergens Co. v. Woodbury, Inc.*, 273 Fed., 952, the court found that "the agreement discloses a purpose to transfer * * * all rights in the trade-mark * * *." Viewed in this light the decision is in entire harmony with *Littlefield v. Perry* and *Gayler v. Wilder*. If there was a purpose to transfer all the rights in the trade-mark the instrument was of course an assignment.

Such a purpose, however, cannot be gathered from the March, 1917, agreement in the case at bar, because that instrument purported to grant a mere license under such rights as the DeForest Company had *except* the rights expressly reserved to it. The rights reserved, therefore, never passed to the licensee.

CONCLUSION.

It is respectfully submitted that if it becomes necessary to pass upon the question of title to the patents in suit, that it should be held to be in the DeForest Company.

Respectfully submitted,

THOMAS G. HAIGHT,
Amicus Curiae.